

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

In re Patent Application of

Atty Dkt. LSN-36-1481

C# M#

Confirmation No. 4008

TC/A.U.: 3627

Examiner: V. Frenel

Date: February 7, 2008

ANDERSON et al

Serial No. 09/914,295

Filed: August 27, 2001

Title: BILL PROCESSING SYSTEM



Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

☐ **Correspondence Address Indication Form Attached.**

☐ **NOTICE OF APPEAL**

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences

from the last decision of the Examiner twice/finally rejecting applicant's claim(s). \$510.00 (1401)/\$255.00 (2401) \$

☒ An appeal **BRIEF** is attached in the pending appeal of the above-identified application \$510.00 (1402)/\$255.00 (2402) \$ 510.00

☐ Credit for fees paid in prior appeal without decision on merits -\$ ()

☐ A reply brief is attached. (no fee)

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s)
One Month Extension \$120.00 (1251)/\$60.00 (2251)
Two Month Extensions \$460.00 (1252)/\$230.00 (2252)
Three Month Extensions \$1050.00 (1253)/\$525.00 (2253)
Four Month Extensions \$1640.00 (1254)/\$820.00 (2254) \$

☐ "Small entity" statement attached.

Less month extension previously paid on -()

TOTAL FEE ENCLOSED \$ 510.00

☐ **CREDIT CARD PAYMENT FORM ATTACHED.**

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension. The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37(c)

Sir:

Applicant has appealed to the Board of Patent Appeals and Interferences (Notice of Appeal filed December 7, 2007) from the last decision of the Examiner (Final Office Action dated August 7, 2007). An appeal brief pursuant to 37 C.F.R. § 41.37(c) is now presented.

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(I) REAL PARTY IN INTEREST

The real party in interest is British Telecommunications public limited company, a British corporation of the United Kingdom.

(II) RELATED APPEALS AND INTERFERENCES

The appellant, the undersigned, and the assignee are not aware of any related appeals, interferences, or judicial proceedings (past or present), which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

(III) STATUS OF CLAIMS

Claims 1-5 are pending and have been rejected. The rejection of claims 1-5 is being appealed. No claims have been substantively allowed.

(IV) STATUS OF AMENDMENTS

No amendments have been filed since the date of the Final Rejection.

Accordingly, the current status of the claims is the same as that presented in the Amendment filed May 11, 2007.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

Each independent claim, each dependent claim argued separately, and each claim having means plus function language is summarized below including exemplary reference(s) to page and line number(s) of the specification.

A. Introduction

The invention of the claims relates to editing in a computer implemented billing system a bill image having a number of records. Each record has an assigned charge type identifier (CTI), with the format of the bill image being dependent on the CTIs of the respective records. A set of data structures is established and each record of the bill image is converted into a record held in one or more of the data structures in dependence on the CTI of the respective bill image record. One or more of the records held in the data structure is edited, and the records held in the data structures are used to create a new bill image. A bill image to be edited is disassembled into a number of records, each record representing a particular entry in the bill image. These records can then be edited by a user through a menu interface. The edited records are used by a bill generation system to reassemble the bill image reflecting changes made by the user.

B. Independent Method Claim 1

Independent method claim 1 relates to a method of editing an electronic bill image having an appearance associated therewith (page 5, lines 19-20; bill image 50 in Fig. 1; Fig. 8). The electronic bill image has a number of records (page 5, lines 19-20; page 11, lines 23-24; table on page 12). The electronic bill image is stored in a computer

implemented billing system (page 20, lines 1-21; system of Fig. 1 including bill generator 60 and bill image 50; tree of Fig. 4). Each record has an assigned charge type identifier (CTI) stored in the computer implemented billing system (page 5, line 20; page 10, lines 13-15; table on page 13). The format of the appearance of the electronic bill image is dependent on the CTIs of the respective records (page 5, lines 20-21; page 22, line 1 to page 23, line 2; example arrangements of Figs. 5a-5e; tree of Fig. 4). A set of data structures is established (page 5, line 22; page 25, lines 13-23; 700-740 in Fig. 7a). Each record of the bill image is converted into a record held in one or more of the data structures in dependence on the CTI of the respective bill image record (page 5, line 22 to page 6, line 1; page 29, lines 1-24; 810-850 of Fig. 8). One or more of the records held in the data structures is/are edited (page 6, line 1; page 30, lines 6-10; 860 in Fig. 8). The records held in the data structures are used to create a new electronic bill image, with the new electronic bill image having a new appearance (page 6, lines 1-2; page 30, lines 12-13; 870 in Fig. 8).

C. Dependent Claim 4

Dependent claim 4 further requires a computer implemented bill image editor comprising at least one computer readable memory storing computer executable instructions for performing the method of independent claim 1 (page 6, lines 12-14; page 9, lines 15-16; inherent in the system of Fig. 1).

D. Independent System Claim 5

Independent claim 5 relates to a computer implemented electronic bill image editing system for editing an electronic bill image having an appearance associated therewith (page 5, lines 19-20; page 9, lines 11-16; bill image 50 in Fig. 1; Fig. 8). Means for establishing a set of data structures are provided (page 5, line 22; page 25, lines 13-23; 700-740 in Fig. 7a). Means for converting each record of an electronic bill image into a record held in one or more of the data structures in dependence on an assigned charge type identifier of a respective bill image record are provided (page 5, line 22 to page 6, line 1; page 29, lines 1-24; 810-850 of Fig. 8). Means for editing of one or more of the records held in the data structures are provided (page 6, line 1; page 30, lines 6-10; 860 in Fig. 8). Means for creating a new bill image using the records held in the data structures, with the new electronic bill image having a new appearance, are provided (page 6, lines 1-2; page 30, lines 12-13; 870 in Fig. 8).

(VI) GROUND OF REJECTION TO BE REVIEWED ON APPEAL

All claims 1-5 have been rejected as allegedly being made “obvious” over Peters et al. (U.S. Patent No. 5,884,284) in view of Hogan (U.S. Patent No. 5,699,528) under 35 U.S.C. § 103(a).

(VII) ARGUMENT

All claims 1-5 have been rejected as allegedly being made “obvious” over Peters et al. (U.S. Patent No. 5,884,284) in view of Hogan (U.S. Patent No. 5,699,528) under 35 U.S.C. § 103(a). This rejection is respectfully traversed for at least the following reasons.

First, Applicant respectfully submits that the prior art of record, alone and in combination, fails to teach or suggest editing a bill image. Peters, the “base reference” in this Section 103 rejection, is concerned with a Cable Service Provider company general management computer system. Naturally, such a system does include a billing function. Although this functionality is mentioned in Peters, it is more of an aside than a core part of the “invention” to which Peters is directed (which would seem to relate to a method of controlling a device referred to in Peters as a “cable converter,” or simply as a “converter”). As explained at column 5, lines 24-37 of Peters, a “cable converter” is a device located at each subscriber’s dwelling that performs television signal decoding to enable “special channels” to be watched by the subscriber either permanently or on a pay-per-view basis (presumably, this refers to a cable box).

Peters discusses billing abilities of the system (referred to generally as SAM), albeit somewhat in passing, at column 29, lines 3-20. This portion of Peters is referred to by the Examiner on page 2 of the Non-Final Office Action dated January 11, 2007, and it is again cited in the Final Office Action dated August 7, 2007. This paragraph of Peters simply states that the system is able to gather together relevant data for generating a bill and then is capable of generating such a bill. No information is given as to how this is

done. This lack of detail is not that surprising, since such a disclosure would be rather peripheral to the “invention” with which Peters is concerned.

Applicant does not suggest that it has invented the general concept of automatically generating a bill from usage data -- indeed, this was general common knowledge in the prior art. Accordingly, in this portion of Peters, all that is really “taught” is the general common knowledge of automatically assembling usage data in a format suitable for presenting as a bill to a user. Furthermore, this is all that is taught by Peters with respect to bill generation in the entire issued patent. Again, since bill generation is not a major concern of the invention described in Peters, this is not surprising.

Nowhere in Peters is there any mention of editing a bill image. For example, in contrast, column 29 of Peters merely describes creating the bill image in the first place.

As column 29, lines 3-17 of Peters states:

“Upon indication of a billing generation requirement for a particular subscriber, the present invention accesses the database for that subscriber, collects current unbilled usage data for billing (including regular monthly fees, pay-for-view fees, and equipment and maintenance charges), historical information (such as balances forwarded and recent payments yet to be credited), and any other information to be included on the bill (such as announcements and advertising). The invention then prepares a bill for the subscriber on a standard format. The bill images are sent to a printing house where they are printed, placed in individual envelopes, and mailed to each subscriber. Then, the system’s databases are updated accordingly (particularly regarding indications of what has been billed and is now an account receivable).”

While this passage does teach the creation of a bill image, there is nothing in this passage about thereafter editing the appearance of such a bill image. Insofar as Peters nowhere

teaches any kind of editing of a bill image, Applicant agrees with the Examiner's assertion at page 4 of the Final Office Action that this portion of Peters does "correspond to" Applicant's argument -- indeed, this portion of Peters fully supports it.

Second, there appears to be some equivocation on the part of the Examiner as to where exactly in the applied references the assignment of charge type identifiers (CTIs) to records appearing in a bill image is to be found. In particular, page 2 of the Non-Final Office Action alleges that it is to be found in Peters, while page 4 of the Final Office Action alleges that it is to be found in Hogan. Notwithstanding this confusion, Applicant respectfully submits that neither Peters, nor Hogan, nor the alleged combination thereof, includes any teaching or suggestion with respect to the assignment of CTIs to records appearing in a bill image, at all. The Non-Final Office Action and the Final Office Action are discussed, in turn, below.

The portion of Peters cited on page 2 of the Non-Final Office Action (i.e., column 17, line 39 to column 18, line 23) has nothing to do with bill generation at all. Rather, it is concerned with something more relevant to the actual "invention" of Peters -- namely, how to use SAM to modify information stored by SAM about a particular cable converter device such as its location, etc. Contrary to the Examiner's implicit assertion, there is nothing in this section that seems to correspond in any way to a charge type identifier (CTI).

Since the Examiner has conceded that all parts of the claim after the second line are not disclosed in Peters, it follows that no part of the claim is actually disclosed in

Peters at all -- that is, Peters discloses creating a bill image (but not editing it) and does not describe assigning charge type identifiers to records appearing in a bill image.

Hogan is similarly deficient with respect to this feature of the independent claims. The Final Office Action states that the Examiner relied on Figures 3 and 9 and column 10, lines 1-30 of Hogan as disclosing the above-noted feature (even though the Non-Final Office Action clearly indicates otherwise as demonstrated above). Assuming that the Examiner is relying on Hogan for this teaching, it is again noted that Hogan is directed towards electronic bill payment but not at all towards editing the bill image -- much less using charge type identifiers to facilitate such editing. Consistent with this positive teaching of Hogan, Figure 3 merely provides a screen that permits the user/bill payer to select as one option at block 203 to “receive and pay bills.” Other options on this screen permit the user to select new payees, to update the electronic account register, and to review payments earlier made. It is also possible to obtain an account balance and to seek “help.” There is nothing here -- or anywhere in Hogan -- about assignment of a “charge type identifier” to records appearing in a bill image.

Similarly, Figure 9 simply provides a menu of user options including “view and/or pay bills,” “view payment confirmation,” “view administrative messages,” and “exit.” There is nothing in Figure 9 about the assignment of a CTI to records appearing in a bill image.

Similarly, the entirety of the text cited by the Examiner is quoted below to demonstrate that this portion of Hogan is also deficient:

“Utilizing a standard receipt confirmation feature of the e-mail service, server computer 160 would receive an acknowledgement message through network 110 when the electronic bill is received and opened by the subscriber. This acknowledgement message includes a time stamp indicating the date and time when the electronic bill was opened, the subscriber’s e-mail address indicating where the acknowledgement comes from and the information in the “subject” field of the electronic bill, which identifies the bill by including the payee’s name, bill amount and payment due date. In accordance with another aspect of the invention, the EBSC is alerted by computer 160 to those electronic bills whose acknowledgement messages have not been received before their respective due dates. The alert may take the form of a daily print-out of the outstanding bills from computer 160. Upon reading the print-out, in order to avoid overdue payments, the EBSC will attempt to inform the subscriber of his/her outstanding bills by other means of communications such as regular mail.”

“In operation, upon invocation the electronic bill payment program first checks for any electronic bills unopened by the subscriber, as indicated at step 801 in FIG. 8A,. This is done by reading the open status bits of all the electronic bills saved including the newly arrived bills. If any unopened bill is detected, the program at step 803 causes display 107 to exhibit an announcement such as “YOU HAVE UNOPENED BILLS!” to alert the subscriber to read the bills. In either event, the program proceeds to step 805 where the pay status bits of all the previously opened bills are checked to see whether they have been paid. If unpaid bills are detected, the program at step 807 causes display 107 to exhibit another announcement such as “YOU HAVE UNPAID BILLS!” to alert the subscribers that not all the opened bills have been paid. In either event, the program proceeds to step 809 where it causes display 107 to exhibit menu 901 as shown in FIG. 9.”

Perhaps even more importantly, Hogan has nothing at all to do with editing the appearance of a bill image. As previously explained, Hogan only relates to providing an ability to pay a presented bill electronically. The image of the bill presented to the user/payer (if any) is controlled elsewhere. The payer of the bill does not have the ability to edit the appearance of the bill. The Examiner has not been able to identify any teaching or suggestion to the contrary in either of the cited references.

Third, Applicant respectfully submits that the prior art of record, alone and in combination, fails to teach or suggest how an individual payee edits or even generates a bill image. Both the Non-Final Office Action and the Final Office Action appear to rely on Hogan as allegedly disclosing this feature (although the Non-Final Office Action and the Final Office Action appear to cite different portions of Hogan in support of the Examiner's contentions). It is once again noted that Hogan is concerned with an electronic billing system. In this respect, the general architecture of the overall system in Hogan is that there is an electronic bill payment service provider which acts as an intermediary between a number of "payees" (people who generate bills and want them to be paid by their customers) and a number of "subscribers" (customers being billed). The invention of Hogan is concerned primarily with the intermediary bill payment service provider, and not with the operation of individual payees.

All that is said about bill image generation in Hogan appears at column 4, line 53 to column 5, line 14, where it simply provides that each payee, instead of printing out a bill image, sends it to a bill capture device 150, "after the images are created but before they are printed." Since the payees naturally are responsible for generating bills for sending to their clients, it is only reasonable that the intermediary service provider should not thereafter edit the bill image (since this could then result in a customer of the payee being misled about the amount of money owed, etc.), and it is therefore not surprising that there is no disclosure in Hogan of the intermediary system editing the bill images at all – rather, they are provided as they are to the subscribers for viewing. Also, since

Hogan is not really concerned with how the payees generate their bill images, it is again not surprising that Hogan again fails to disclose how an individual payee edits or even generates a bill image.

In the Non-Final Office Action, the Examiner refers to column 4, line 36 to column 5, line 43 of Hogan as support for the assertion that Hogan “suggests that the method having a format of the appearance of the electronic bill image being dependent on the CTIs of the respective records, the method including the steps of establishing a set of data structures, converting each record of the bill image into a record held in one or more of the records held in the data structures, and using the records held in the data structures to create a new electronic bill image having a new appearance.”

However, a reading of the portion of Hogan referred to in the Non-Final Office Action does not reveal any of these things being suggested. Rather, the cited passage seems only to describe how payees send their bills to a bill capture device of the intermediary system which then forwards the bills on to a web server from where subscribers may view and pay their bills -- which happens to be in the exact same form in which the payees sent them to the intermediary. There is no disclosure of changing the appearance of the bill image in any way whatsoever, much less by converting each record of the bill image into a record held in one or more data structures in dependence on the CTI of the respective bill image record, etc.

The Examiner also asserts in the Final Office Action that such a feature is found in Hogan at column 7, lines 27-65. However, Applicant has been unable to find any such

teaching or suggestion at this (or any other) portion of Hogan. For convenience, the entirety of the text cited by the Examiner in the Final Office Action is quoted below to demonstrate the fact that there is no such teaching here:

“At step 314, if ‘Update Electronic Account Register’ choice 207 is selected, server computer 160 retrieves confirmed payment data and causes an update, taking into account the confirmed payments, to an electronic account register provided by the subscriber’s financial management software of the type of QUICKEN, MICROSOFT MONEY or MANAGING YOUR MONEY preloaded on PC 100. Server computer 60 also causes the software to show the updated register on display 107, as indicated at step 394.”

“If ‘Review Payments’ choice 211 is selected at step 314, server computer 160 retrieves the confirmed payment data, and the payment records created at step 378 described above, and causes display 107 to show records of payment with indications of ‘confirmed’ status for those payments which were confirmed, as indicated at step 393.”

“If ‘Help’ choice 209 is selected at step 314, server computer 160 causes display 107 to present a description of the electronic bill payment service including current service functions, rules and procedures, etc., as indicated at step 395.”

“If ‘Select New Payees’ choice 205 is selected at step 314, server computer 160 causes display 107 to list all the payees previously identified by the subscriber, and enables the subscriber to add new payees to or delete selected payees from the list, as indicated at step 399. Upon learning the changes in the payee list, he personnel of the EBSC accordingly establishes or cancels the electronic bill payment service with the corresponding payees.”

As will be appreciated, this section of Hogan gives the user/bill payer several options in the payment of bills, but it does not teach or suggest any capability for the individual bill payer to edit or generate a bill image. In particular, any bill image displayed to the bill payer was earlier generated in some undisclosed process by the vendor (i.e., the “payee”) whose bill is being paid. The bill payer would not appear to have any option to change that bill when making payment. Clearly, since this section of

Hogan relates to the options available to a bill payer rather than the payee (i.e., the vendor being paid), it is also clear that there is no teaching in this section of Hogan that permits a payee to edit its bill image.

Fourth, and particularly in view of the above, Applicant respectfully submits that neither Peters, nor Hogan, nor the alleged combination thereof, describes a method of editing a bill image, or any other method involving any of the steps set out in the independent claims. Insofar as neither of the references are related to bill image editing and neither of the references seems to describe any of the claimed features, the present invention as claimed could not possibly be anticipated or rendered obvious in view of either of the applied references, alone or in combination.

The Examiner presents an extensive section of text bridging pages 5-7 of the Final Office Action which appears to have been generated with respect to a different case. For example, the Examiner refers to an alleged misinterpretation by Applicant of some of the case law cited. However, Applicant's earlier arguments to-date have not cited any case law at all.

Applicant agrees that obviousness must be determined on the basis of the evidence as a whole. Of course, the relative persuasiveness of arguments is to be considered.

However, using such a standard, the Examiner clearly has not yet presented a *prima facie* case of obviousness since the Examiner has not presented evidence of corresponding claim elements in the prior art. Moreover, contrary to the assertion in the Final Office Action, the Examiner has not expressly articulated the "combinations and

the motivations for combinations that fairly suggest applicant's claimed invention." In the context of cited prior art that fails to teach any of the claimed features, it is hard to understand how one of ordinary skill in the art at the time of the invention would have found it "obvious" to make any combination of the features that are actually disclosed in either of these two references. And even if all the features of both references are somehow "combined," they still necessarily fail in that combination to teach or suggest many of Applicant's claimed features, including those noted above.

The Examiner argues that the outstanding grounds of rejection, which combines alleged features of these references, is "based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention." However, it is not understood how "logic and scientific reasoning" can create something out of whole cloth. Unless the claimed features of Applicant's invention can be found in at least one of the cited references, there is no "logic and scientific reasoning" available that would permit the combination of these references to somehow cause such features to appear for the first time -- much less to then be combinable in the manner alleged by the Examiner.

Applicant does agree with the Examiner's quotation from prior case law to the effect that "[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." However, for reasons already noted, Applicant respectfully submits that the Examiner in this case has not yet satisfied this agreed upon burden. That is, so far as Applicant can

ascertain, there are no objective teachings or suggestions in the cited prior art of many of the claimed features of the Applicant's invention -- much less any knowledge to be gleaned from the four corners of these prior art patents that, even if combined, would demonstrate knowledge generally available to one of ordinary skill in the art that would lead that individual to combine purportedly "relevant teachings" of the references.

The Examiner alleges, to the contrary, that all modifications proposed by the Examiner are "specifically taught by the references." However, the Examiner's allegations are not supported by the portions of these references referred to in the Office Actions. Furthermore, Applicant has studied the entirety of these references and fails to find anywhere in these references the features the Examiner alleges to find. If there are specific and explicit teachings as alleged by the Examiner in either of the applied references, then the Examiner has failed to identify them and the Applicant similarly has been unable to unearth them.

This is perhaps best demonstrated by the fact that the Examiner has failed to identify within either of the applied references where even the broad concept of editing a bill image appears -- much less editing a billing image based on charge type identifiers or the like.

In sum, the Examiner has failed to present a *prima facie* case of obviousness, at least because the Examiner has failed to (1) identify where in the prior art a number of features of the claimed invention are to be found, and also to (2) articulate how and why any of these ethereal features should be combined, even if they did exist. Accordingly,

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Applicant respectfully requests that the rejection of claims 1-5 under 35 U.S.C. § 103(a) be reversed.

CONCLUSION

In conclusion it is believed that the rejection of claims 1-5 is erroneous and should be reversed.

Respectfully submitted,

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(VIII) CLAIMS APPENDIX

1. A method of editing an electronic bill image having an appearance associated therewith, the electronic bill image having a number of records, the electronic bill image being stored in a computer implemented billing system, each record having an assigned charge type identifier (CTI) stored in the computer implemented billing system, the format of the appearance of the electronic bill image being dependent on the CTIs of the respective records, the method comprising:

establishing a set of data structures,

converting each record of the bill image into a record held in one or more of the data structures in dependence on the CTI of the respective bill image record,

editing one or more of the records held in the data structures, and

using the records held in the data structures to create a new electronic bill image, the new electronic bill image having a new appearance.

2. A method according to claim 1, further comprising:

processing each record held in the data structures in dependence on its assigned CTI to create the new electronic bill image, the format of the appearance of the new electronic bill image being dependent on the CTIs of the records.

3. A method according to claim 1 wherein:

each record of the electronic bill image relates to one of a group consisting of: a call charge, a rental charge, a discount, a discount scheme definition, accounting data, customer account data, and product subscription data.

4. A computer implemented bill image editor comprising at least one computer readable memory storing computer executable instructions for performing the method of claim 1.

5. A computer implemented electronic bill image editing system for editing an electronic bill image having an appearance associated therewith, the system comprising:

means for establishing a set of data structures;

means for converting each record of an electronic bill image into a record held in one or more of the data structures in dependence on an assigned charge type identifier of a respective bill image record;

means for editing of one or more of the records held in the data structures; and,

means for creating a new bill image using the records held in the data structures, the new electronic bill image having a new appearance.

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(IX) EVIDENCE APPENDIX

None.

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(X) **RELATED PROCEEDINGS APPENDIX**

None.